

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILLES WALCH and PASCAL BOILEAU

Appeal No. 2002-0282
Application No. 09/363,407

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 11 through 14. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a humeral prosthesis set for the upper extremity of the humerus. A basic understanding of the invention can be derived from a reading of exemplary claim

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11, a copy of which appears in "APPENDIX A" to the brief (Paper No. 13).

As evidence of obviousness, the examiner has applied the document specified below:

Tornier	5,358,526	Oct. 25, 1994
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The following rejection is before us for review.

Claims 11 through 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tornier.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 14), while the complete statement of appellants' argument can be found in the brief (Paper No. 13).

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied patent,¹ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

This panel of the Board does not sustain the examiner's rejection on appeal for the reasons appearing below.

We focus our attention upon appellants' independent claim 11.

¹ In our evaluation of the applied reference, we have considered all of the disclosure of the patent for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Claim 11 is drawn to a humeral prosthesis set for the upper extremity of the humerus, the set comprising, inter alia, a plurality of single piece stems, with the bearing surface of each stem being oriented at a tilt angle such that each tilt angle differs from a tilt angle of the bearing surfaces of other stems in the set, and a least one hemispherical cap.

We fully appreciate the examiner's assessment of the overall disclosure of the Tornier reference, and the reasoning leading to the stated conclusion of obviousness, as set forth in the answer. However, as we see it, the humeral prosthesis set of claim 11 would not have been suggested by the Tornier patent itself, considered in its entirety. Clearly, the patentee Tornier instructs those versed in the art to rely upon three elements of a modular prosthesis (stem 1, spacer 2, and cap 3), with a particular spacer being chosen from a series of spacers of different slopes so that the inclination of the cap can be adjusted according to a clinical case (column 3, lines 4 through 6 and lines 63 through 66). This, of course, is not appellants' invention. On the other hand, like the examiner, we appreciate from the Tornier disclosure that, prior to the patented invention, those practicing the art also had available to them

other alternatives, as follows. First, a large number of monobloc prostheses of fixed inclination from which one could be selected to meet the need of a particular patient (column 1, lines 23 through 35). Second, a prosthesis stem having fixed thereto one of a number of different ball-and-socket joints for effecting a favorable angle of inclination (column 1, lines 36 through 52).

Considering the particular Tornier invention and the background alternative options clearly discussed in the Tornier reference, it is quite apparent to us that the humeral prosthesis set of claim 11 simply would not have been obvious therefrom to one having ordinary skill in the art, unless appellants' own teaching was impermissibly taken into account. It is for this reason that we cannot support the rejection of appellants' claims based upon the Tornier teaching.

In summary, this panel of the board has not sustained the obviousness rejection of claims 11 through 14.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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